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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Jeff W. Lichtman, et al. Art Unit: 1651  
Patent No. 6,869,772  
Issue Date: March 22, 2005  
Confirmation No. 8528  
For METHOD FOR LABELING INDIVIDUAL CELLS  
Examiner Jon P. Weber

May 5, 2005

LETTER REGARDING ERROR IN PATENT TERM ADJUSTMENT

TO THE COMMISSIONER FOR PATENTS,  
SIR:

In response to the Issue Notification dated March 2, 2005, Applicants respectfully request reconsideration of the patent term adjustment determination. Applicants hereby notify the Office that the term adjustment is thought to be longer than appropriate, pursuant to Comment 43 of the rules listed in Federal Register Vol. 65, No. 181 at page 56387 (Sept. 18, 2000). Applicants submit the following statement of facts in support of their request for reconsideration.

The Office has indicated that the application is entitled to a patent term adjustment of ninety-nine (99) days. However, applicants believe that the correct adjustment is twenty-one (21) days.

The application was filed on March 9, 2001. The first Office action (restriction requirement) was mailed on April 30, 2002, which is within fourteen (14) months of the filing date. The response to the first Office action was filed on May 30, 2002, which is within the three (3) month period for response. The second Office action was mailed on August 6, 2002, which is within the four (4) month period for reply by the Office. The response to the second Office action was filed on December 6,

2002, which is thirty (30) days after the three (3) month period for response. The third (final) Office action was mailed on March 4, 2003, which is within the four (4) month period for reply by the Office. A Notice of Appeal was filed on July 7, 2003, which is thirty-three (33) days after the three month period for response. A response to the third Office action and a Request for Continued Examination were filed October 7, 2003, which is thirty (30) days after the two (2) month period of reply following a Notice of Appeal. A Notice of Allowance was mailed on December 29, 2003, which is within the four (4) month period for reply by the Office, and indicated that the subject application was entitled to a patent term adjustment of zero (0) days. The issue fee was paid on March 29, 2004, which is within the three (3) month period for payment of an Issue Fee, along with a letter submitting Formal Drawings and a letter submitting a Supplemental Declaration. The Issue Notification was mailed on March 2, 2005 and indicated the patent would issue on March 22, 2005, which is two hundred and thirty-six (236) days after the four (4) month period for issuance of a patent subsequent to the payment of an issue fee. The Issue Notification further indicated that the subject application is entitled to a patent term adjustment of ninety-nine (99) days.

Applicants acknowledge that patent term adjustment can be reduced due to failure to engage in reasonable efforts to conclude prosecution of the application according to 37 CFR §1.704. Based on the above recited facts, the delay on the part of the applicant pursuant to 37 C.F.R. §1.704(b) is ninety-nine (99) days.

In addition, pursuant to 37 CFR 1.704(c)(10), the submission of an amendment under §1.312 or other paper after a notice of allowance has been mailed results in a reduction of patent term by the lesser of (i) the number of days beginning on the date the paper was filed and ending on the mailing date of the Office action or notice in response to the paper or (ii) four months.

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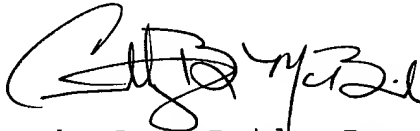
As stated above, applicants mailed a letter submitting Formal Drawings and a letter submitting a Supplemental Declaration along with the Issue Fee on March 29, 2004, and the patent issued on March 22, 2005. Since March 22, 2005 is more than 4 months from the mailing date of the Supplemental Declaration and Formal Drawings, the patent term should be reduced by four (4) months, or one hundred twenty-two (122) days under §1.704(c)(10).

Based on the above recited facts, the delay on the part of the Office was two hundred thirty-six (236) days. The delay on the part of applicants was two hundred fifteen (215) days. The result is a patent term extension of twenty-one (21) days.

Accordingly, it is believed that the patent term adjustment should be reduced from ninety-nine (99) days to twenty-one (21) days.

Applicants believe that no fee is due for the filing of this letter.

Respectfully submitted,



Timothy B. McBride, Reg. No. 47,781  
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